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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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InUnison Integrated Systems Ltd.
v.
Appiant Technologies, Inc.

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Opposition No. 91151960 to application Serial No. 76158865
filed on November 2, 2000

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Request for Reconsideration

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Patrick R. Roche, Sandra M. Koenig and Erik J. Overberger of Fay, Sharpe, Fagan, Minnich & McKee, LLP for InUnison Integrated Systems Ltd.

Michael J. Hughes of IPLO Intellectual Property Law Offices for Appiant Technologies, Inc.

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Before Simms, Quinn and Hohein, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

The Board, in a majority opinion issued on July 29, 2004, issued a decision dismissing the opposition by InUnison Integrated Systems Ltd. to the application by Appiant Technologies, Inc. for registration of the mark "INUNISON" for the services of "providing online application hosting services in the field of contact management, personal information hubs and calendar management." Specifically, while finding that opposer, as the party bearing the burden of proof in this proceeding, had

shown that confusion is likely from the contemporaneous use by applicant of such mark in connection with the above noted services and the use by opposer of the same mark with respect to "website design, hosting and maintenance services," the majority also held that, in the absence of proof that opposer is the owner of superior rights in the "INUNISON" mark, opposer could not prevail on its claim of priority of use and likelihood of confusion. Opposer, by a certificate of mailing dated August 30, 2004, has timely filed a request for reconsideration of the Board's decision "to the extent that it failed to recognize Opposer as the owner of the INUNISON mark and successor in interest to common law rights in the mark." The request for reconsideration is uncontested.

Upon consideration of opposer's arguments, we remain convinced that the majority opinion is factually accurate and, for the reasons stated therein, is legally correct.[1] Therefore,

[1] Opposer admits, in its reconsideration request, that "the Board correctly concluded that ... [r]ights in the mark INUNISON dating back to September 2000 were transferred to ... John Bennett, effective February 7, 2001," thereby rebutting, as the majority also found, the admissions by applicant in its answer that opposer is the owner of the "INUNISON" mark which is the subject of application Ser. No. 76374554 and that opposer has used such mark "continuously, through a predecessor in interest, since at least as early as September 2000" and continuing to the present time, "in association with website design and maintenance services." It is also clear, as the majority found, that inasmuch as opposer had "its inception on November 21, 2000," this is not a case where, as argued by opposer, an individual's rights in a mark may be presumed to inure to the benefit of a corporation subsequently organized by such individual; instead, it is plain that, in light of the effective date of February 7, 2001, ownership rights in the "INUNISON" mark were transferred to John Bennett after opposer was organized. Consequently, opposer failed to prove that it has priority of use since, as of the close of the trial herein, ownership of any rights in the "INUNISON" mark to which it may have at one time possessed resided with John Bennett rather than opposer.

because opposer has demonstrated no error in such decision, the request for reconsideration is denied.[2]

Simms, Administrative Trademark Judge, dissenting:

For the reasons previously expressed in my dissent on July 29, 2004, I believe that opposer should prevail on this record.

First, applicant admitted in its answer that opposer is the owner of the INUNISON mark, that the mark is the subject of opposer's pleaded application, that opposer used this mark continuously through a predecessor since at least September 2000, and that applicant's mark is identical to opposer's mark. These admissions establish opposer's standing as well as opposer's priority. At trial, applicant failed to prove any use, let alone use prior to September 2000. The September 2000 date precedes applicant's filing date.

Even without these admissions, opposer is entitled to prevail. Even if opposer is not the "owner" of the pleaded mark, it is clear that opposer is an authorized user. Exhibits submitted by Mr. Bennett show prominent use of the mark by opposer. It is clear from Mr. Bennett's submission that opposer is using the mark with his permission, if opposer is not in fact the owner of the mark. In order to prevail in this proceeding, an opposer need not establish ownership of a pleaded mark. A plaintiff may have standing and may succeed if it is a licensed

[2] Opposer, of course, is not without a remedy in these circumstances since it could either petition to cancel a registration which issues to applicant after the opposition is dismissed or opposer could purchase applicant's interest in the opposed application.

or other authorized user of a prior mark, that is likely to cause confusion with applicant's mark.

Moreover, in opposer's request for reconsideration, opposer maintains that Bennett's rights "inure to and belong to" opposer (Request for Reconsideration, 6). Opposer argues that "Since [opposer] is Mr. Bennett's company and Mr. Bennett started and controls his company, and because Mr. Bennett was authorized to submit his evidentiary declaration herein on behalf of his company, it must be concluded that all rights in INUNISON that were owned by Mr. Bennett, including his common law rights dating back to at least as early as September 2000, inure to and have been assigned to Opposer herein." Request for Reconsideration, 8. It appears that if opposer, even with its request for reconsideration, had submitted a *nunc pro tunc* assignment of the mark, the majority may have been satisfied as to opposer's ownership and standing. In any event, and since applicant has again failed to appear and raise any objections to opposer's case, the equities clearly lie with opposer. I would sustain the opposition.